



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, DC 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,164	07/24/2001	Jose Repolles Moliner	14797	4564

7590 02/25/2003

SCULLY, SCOTT, MURPHY & PRESSER
400 Garden City Plaza
Garden City, NY 11530

EXAMINER

LUKTON, DAVID

ART UNIT	PAPER NUMBER
----------	--------------

1653

8

DATE MAILED 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/912,164

Applicant(s)

Moliner

Examiner

David Lukton

Art Unit

1653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 29, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 12-18 is/are pending in the application.
- 4a) Of the above, claim(s) 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 6) ☐ Other: _____

Claims 1-9, 12-18 remain pending.

Applicants' election of Group I with traverse is acknowledged, as is the elected specie. Applicants have traversed the restriction requirement. However, claim 18 will be rejoined with Group I after Group I has been determined to be allowable. Claim 18 is withdrawn from consideration at this time.

✱

The abstract is objected to. The first sentence should be grammatically complete. A grammatically complete sentence has both a "subject" and a "predicate" which is currently lacking. For example, the following sentence is grammatically complete:

S-nitrosothiol derivatives of formula I are disclosed.

In addition, the abstract should be reduced in length by at least 6 lines of text. Also, only one paragraph is permitted in an abstract; currently there are two.

✱

Claims 1-9, 12-17 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1 recites the following:
"S-nitrosothiols derivatives of penicillamine or glutathione"

This is objected to on grammatical grounds. If this phrase is going to be retained, the phrase at issue should be preceded by the indefinite article ("a"), and the singular of both "S-nitrosothiols" and "derivatives" used.

- Claim 1 recites the following: "its pharmaceutically acceptable salts". Here, "its" tends to convey some sort of possession, which is not appropriate.
- Claim 1 recites the following: "...derivatives... which correspond to ... formula I". In what way do the derivatives "correspond" to formula I...? It is suggested that the first three lines of claim 1 be deleted and replaced with either of the following:

- - *A compound of formula I, or a pharmaceutically acceptable salt thereof* - -

- or -

- - *An S-nitrosothiol derivative of penicillamine or glutathione of formula I, or a pharmaceutically acceptable salt thereof* - -

- The claims use the term "rest". However, this is not a generally recognized term in organic chemistry. It is suggested that one of the following terms be used, if consistent with intentions: *group, substituent or moiety*.
- In each of claims 1, 2 and 6, there is a hyphen between the claim number and the first word of the claim. This hyphen should be eliminated.
- Claim 1 recites (page 35, lines 13-14) "bound via its non amino acid carboxyl". First, "bound" should instead be *bonded*. Second, the phrase *gamma-carboxyl group* would be better than "non amino acid carboxyl" (if consistent with intentions).
- In claim 6, the term "general" is superfluous and can be eliminated.
- In claim 6, it is recited that "A and B have the values mentioned above". Here it should be made clear what "above" refers to.
- In claim 13, the following is recited: "methylnpiperi-din". However, this hyphen is superfluous. See also claims 15 and 16

Serial No. 09/912,164
Art Unit 1653

- 4 -

*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 703-308-3213. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached at (703) 308-2923. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



DAVID LUKTON
PATENT EXAMINER
GROUP 1800